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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,473	01/29/2001	Michel Philippe	05725.0834	6832

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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/22/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/770,473	PHILIPPE ET AL.
	Examiner	Art Unit
	Michael A. Willis	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 July 2002.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-59 is/are pending in the application.

4a) Of the above claim(s) 31-59 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

Applicant's response of 23 July 2002 is entered. Claims 1-59 are pending. Claims 31-59 are withdrawn from consideration as directed to a non-elected invention. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 23 July 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/770,472 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

Claims 1, 4, 5, 10, 12, 13, 16, 17, 21, 22, 23, and 24 are rejected under 35 USC 112, 2<sup>nd</sup> paragraph, as being indefinite for reasons as stated in a previous Office Action with respect to the phrase "hydrocarbon-based radicals". Applicant argues that the specification and claims make it clear that the hydrocarbon-based radicals may comprise components other than hydrogen and carbon, as in claim 4, which claims substituted hydrocarbon-based radicals and claim 5, which recites hydrocarbon-based radicals interrupted with at least one heteroatom. While applicants may be their own lexicographer, the use of hydrocarbon-based radical as including heteroatoms and

components other than hydrogen and carbon is repugnant to the art. By definition, hydrocarbons contain only carbon and hydrogen. As such the use by the applicant of the term hydrocarbon to include components other than carbon and hydrogen is confusing.

The following new grounds of rejection is made:

***Claim Rejections - 35 USC § 102***

Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al (US Pat. 5,886,041). As indicated in a previous Office Action, the elected species of formula I in which  $R_1=C_8H_{17}-CH=CH-C_8H_{16}-$ ,  $X=-NH-$ ,  $R_2=H$ ,  $R_3=CH_3$ , and  $N=9.8$  is free of the art. The claims are rejected as they read on dipeptides.

Yu discloses compositions for the treatment of skin disorders such as acne (see abstract). The compositions comprise amphoteric compounds such as dipeptides and polypeptides. A specific dipeptide disclosed by Yu is glycylglycine, which meets the limitations of formula (I) where  $R_1=H$ ,  $R_2=H$ ,  $R_3=H$ , and  $n=2$ . Compositions disclosed by Yu include Example 15 and 18 with Gly-Gly and Example 6 with beta-Ala-L-His.

***Claim Rejections - 35 USC § 103***

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al (US Pat. 5,886,041). As indicated in a previous Office Action, the elected species of formula I in which  $R_1=C_8H_{17}-CH=CH-C_8H_{16}-$ ,  $X=-NH-$ ,  $R_2=H$ ,  $R_3=CH_3$ , and  $N=9.8$  is free of the art. The claims are rejected as they read on dipeptides.

The instant invention is directed at a process for the treatment of seborrhea and associated disorders with a polyamino acid derivative of formula (I).

Yu teaches the use of dipeptides for the treatment of skin disorders such as acne (see abstract). The compositions comprise amphoteric compounds such as dipeptides and polypeptides. Yu teaches a variety of dipeptides for the treatment of skin disorders (see col. 5, lines 6-15). Furthermore, Yu broadly teaches short-chain polypeptides containing up to 100 amino acids (see col. 5, lines 6-15). As R2 of claim 1 of the instant invention may comprise other atoms in addition to hydrogen and carbon as indicated in applicant's response, formula (I) is understood by the examiner to include any amino acid. While Yu discloses examples with Gly-Gly (see Examples 15 and 18), the reference lacks examples for the full scope of Yu's teachings.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Yu by the use of a variety of dipeptides, tripeptides, and short-chain polypeptides based on the teachings of Yu that a variety of components are effective. The motivation for the change comes from Yu's teaching that a variety of compounds are similarly effective (see col. 4, lines 29-34).

### ***Conclusion***

As indicated in a previous Office Action, the elected species of formula I in which R1=C8H17-CH=CH-C8H16-, X=-NH-, R2=H, R3=CH3, and N=9.8 is free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-

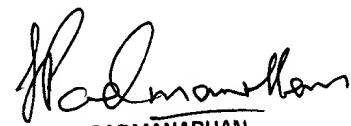
1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
Michael A. Willis  
Examiner  
Art Unit 1617

maw  
October 18, 2002

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
